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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,523	10/30/2003	Helmut L. Kayan	2512 CON2 (203-2719CON2)	7663
Paul R. Audet United States Surgical, a Division of Tyco Healthcare Group LP 150 Glover Avenue Norwalk, CT 06856			EXAMINER LOPEZ, MICHELLE	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 03/18/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/697,523

Applicant(s)

KAYAN ET AL.

Examiner

Michelle Lopez

Art Unit

3721

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is in response to the amendment filed on 12/12/08.
2. New claims 49-50 have been added.
3. The indicated allowability of claim 39 is withdrawn in view of the newly applied reference(s) to Blake, III et al. Rejections based on the newly applied reference(s) follow.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 41-43 and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 41, it is unclear how does the ramp of the first half section assist a fastener to enter the recessed portion of the second half section. It appears that such ramp rather assists the fastener to be urged against the flat side of said second half section
5. In claims 42-43, it is unclear how does the positioning spring urge the distal-most fastener from the recessed region of the first half section to the recessed portion of the second half section. It appears that such positioning spring rather urges such distal-most fastener from the recessed region of the first half section to the flat side of the second half section. Clarification is requested.
6. In claim 46, it is unclear how does the slide shapes a fastener.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 31-33 and 35-50 are rejected under 35 U.S.C. 102(b) as being anticipated by

Blake, III et al. (USPN 4,523,707). Blake, III et al. discloses a fastening apparatus (10), comprising: a handle portion (figs. 1-2; not shown numerically); a triggering mechanism (18); a plurality of vertically stacked fasteners (74) arranged in a linear configuration (); and a fastener applicator (12) connectable to the handle portion, the fastener applicator including: a first half section (upper section of 14; figs. 4a-5a) and a second half section (lower section of 14; figs. 4a-5a), the first half section includes a flat side having a recess region (79) formed therein, the recessed region (79) being configured and dimensioned to retain the plurality of vertically stacked fasteners (74) arranged in a linear configuration (figs. 4a-5a) and slidably receive a pusher (72) therein, the second half (lower section of 14) includes a flat side having a recessed portion (at the vicinity of 48) being configured and dimensioned to slidably receive a slide (22, 48) therein; a fastener positioning spring (86); and a stop spring (76), wherein a distal end of the stop spring (76) engages a fastener adjacent to a distal most fastener (fig. 8).

8. Regarding claims 31 and 48, Blake does show a fastener positioning spring (86) and a stop spring (76), but the location of such springs is opposite to what is claimed. Blake's fastener positioning spring (86) is disposed at the second/lower section rather than being disposed at the first/upper half section and Blake's stop spring (76) is disposed at the first/upper half section, rather than being disposed at the second/lower half section. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have

rearrange the positioning of such springs, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

9. Regarding claims 32-33, Blake, III et al. discloses wherein a distal end of the first/upper half section includes a cut-away region (at the vicinity of 79 on fig. 4a) configured and dimensioned to permit ejection of one of the fasteners (figs. 6a and 7a); wherein a distal end of the second/lower half section has an anvil (61).

10. Regarding claim 35, Blake, III et al. shows wherein the anvil (61) is a cantilever (84) as claimed.

11. Regarding claim 36, Blake, III et al. shows slot regions (not shown numerically) between anvil (61) and side walls (126; fig. 3) and ejector springs (136).

12. Regarding claims 37-39 and 49, Blake, III et al. shows wherein the slide (48) has a distal/center end shaped to complement the anvil (61) via a notch (fig. 3); wherein the slide (48) includes a slotted region (not shown numerically) which alternately restrains (fig. 6a) and releases the stop spring (136, 86) to protrude through the slide (fig. 7a).

13. With respect to claim 40, Blake fails to disclose wherein the notch of the slide has, as its widest width, a distance essentially equal to a width of the slide. It would have been an obvious matter of design choice to have changed the width of the notch as claimed, since such a modification would have involved a mere change in the shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. The change in shape would be for the benefit of properly matching the shape of the anvil, and it is noted that the disclosure fails to indicate anything critical about said width of the slide.

14. Regarding claim 41, Blake, III et al. shows wherein a distal end of the first/upper section includes a ramp (at the vicinity of 79 on fig. 4a) to assist a distal most fastener to enter the recessed portion of the second/lower section.

15. Regarding claims 44-47 and 50, Blake shows wherein the stop spring (76) is configured to retain a fastener adjacent to the distal most fastener of the plurality of fasteners when in the unrestrained state (fig. 8). The slide (48) is configured to urge the stop spring (76) into a restrained state (fig. 6a) and to distally urge a fastener when the slide is advanced distally (fig. 5a). The slide also urge the ejector springs (136) when advanced distally (fig. 6a); wherein after having urged the fastener distally to be shaped (fig. 5a), the ejector springs (136) become unrestrained (fig. 4b) and urged the shaped fastener off the anvil, upon backward movement of the slide.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blake, III et al. (USPN 4,523,707) in view of Taylor (USPN 4,619,262).** Blake, III et al. discloses the claimed fastening apparatus an anvil (61), but fails to disclose wherein said anvil is triangular. Taylor teaches the concept of surgical stapling device having a slide (12) with a notch at the vicinity of (13') being angled to closely match and receive an anvil (20b; fig. 7) having an essentially triangular cross-section to properly bend the legs of a fastener. It would have been

obvious to one having ordinary skill in the art to have provided Blake, III et al.'s anvil with a triangular cross-section as taught by Taylor in order to bend the legs of a fastener.

Response to Arguments

17. Applicant's arguments with respect to claim 31 have been considered but are moot in view of the new ground(s) of rejection.

18. For the reasons above, the grounds of rejection are deemed proper.

Conclusion

19. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Lopez whose telephone number is 571-272-4464. The examiner can normally be reached on Monday - Thursday: 8:00 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle Lopez/
Examiner, Art Unit 3721

/Rinaldi I Rada/
Supervisory Patent Examiner, Art Unit 3721